

REMARKS

Claims 1, 3-11, 13-23, and 25-33 are pending in this application, and claims 1, 5, 11, and 15 are amended herein. The Examiner's Answer mailed May 12, 2009, contained new grounds of rejection of claim 1 under 35 U.S.C. 101. The above amendments to claim 1 are relevant to the new grounds of rejection contained in the Examiner's Answer. The corresponding amendments to independent claims 5, 11, and 15 are made to address the same issues presented in the new grounds for rejection. Accordingly, Appellants submit this reply pursuant to 37 C.F.R. 1.111 requesting entry of the above amendments responding to the new grounds for rejection. See MPEP 1207.03. Appellants further request that prosecution be reopened, if necessary, before the primary Examiner in accordance with 37 C.F.R. § 41.39(b)(1).

After the Final Office Action mailed October 17, 2008, claims 1, 3-11, 13-23, and 25-33 under 35 U.S.C. § 102(e) stood rejected as being anticipated by Gilliam et al. U.S. Patent Number 7,206,765. Appellants presented arguments regarding this rejection in the Appeal Brief filed February 9, 2009, which is hereby incorporated by reference. The Examiner maintains this rejection in the Examiner's Answer.

Referring now to the new rejection under 35 U.S.C. 101, the Examiner asserts that claim 1 is directed towards non-statutory subject matter. Specifically, the Examiner asserts that 1) there is no requirement that a machine be used, and thus, the claims are not sufficiently tied to another class, and 2) the claims may be performed using only human intelligence, and thus, the steps do not sufficiently transform the underlying subject matter to be statutory.

Regarding the Examiner's assertion that claim 1 does not require that a machine be used, and thus, the that claims are not sufficiently tied to another class, Applicants respectfully submit that amended claim 1 recites, in relevant part, "creating a rights expression for association with an item of digital content for use in a digital rights management system for controlling use of the item of digital content in accordance with the rights expression." In addition, claim 1 clearly recites that the use of a "computer" and a "computing device." Thus, it is clear that amended claim 1 requires the use of a machine. Therefore, Applicants believe amended claim 1 is sufficiently tied to a machine to satisfy the requirements of 35 U.S.C. 101.

Regarding the Examiner's assertion that the claims may be performed using only human intelligence, and thus, the steps do not sufficiently transform the underlying subject matter to be statutory, Applicants respectfully submit that amended claim 1 recites, in relevant part, "specifying rights expression information using a computer" and "generating a template of said rights expression information using a computing device." Thus, it is clear that amended claim 1 cannot be "performed using only human intelligence." Therefore, Applicants believe the steps of the amended claim 1 fully satisfy the transformation requirements of 35 U.S.C. 101.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. If, however, the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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